

Remarks

Claims 1-22 stand rejected. Claims 5, 11 and 22 have been amended. In view of the above amendments and remarks set forth below, reconsideration is respectfully requested. No new matter has been entered as a result of this response.

I. Amendment to the Drawings and Specification:

Figure 10 has been amended to show reference numeral 120 and now conforms to the specification at p.8, line 12-13.

The specification has been amended on pages 4 and 5 to correct typographical errors. No new matter has been added as a result of this amendment.

II. Amendment to Claims 5, 11 and 22:

A typographical error in Claim 5 has corrected by including the word “by” after “surrounded”. Claim 11 has been amended to correct a typographical error and to conform to the language of Claim 10 and antecedent language of Claim 4 by replacing “contact surface” with “rectifier bridge”. The term “with” has been replaced by “within” before “the aperture” to correct a typographical error in Claim 22. No change in scope of these claims was intended the result of these amendments.

III. Rejection of Claims 20-22 under 35 USC 112, 2nd para.:

Claims 20-22 stand rejected under 35 USC 112, 2nd para. as being indefinite. Applicant's is grateful for the Examiners sharp eye as these claims were intended as product-by-process claims. It was a typographical error that the proper language to invoke this claim choice was not included. Claims 20-22 have been amended to properly conform to product-by-process

terminology. It is believed that this rejection has been overcome by the amendments and no change in scope was intended as a result of these amendments.

IV. Office Action Not In Accordance with MPEP 706

Applicant contends the Office Action is improper given the fact that the Office Action fails to clearly articulate and clearly explain the pertinence of the references cited to the presently pending claims and the rejections under 35 USC 102 and 103, respectfully, in accordance with MPEP 706 and 37 CFR § 1.104.

37 CFR § 1.104(c)(2) states: "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the **particular part relied on must be designated** as nearly as practicable. The pertinence of each reference, if not apparent, must be **clearly explained and each rejected claim specified.**" (Emphasis added.)

In the Application filed on July 30, 2003, Applicant provided four claim sets identified by independent Claims 1, 13, 16 and 20 and their respective dependent claims.

In the Office Action the rejection based upon 35 USC 102 set forth in paragraph 2 of the Office Action initially purports to be rejecting independent Claims 1 and 20 and their respective dependent claims. While the rejection based upon 35 USC 103 set forth in paragraph 4 of the Office Action initially purports to be rejecting independent Claims 13 and 16 and their respective dependent claims.

In the De Petris patent, patent no. 6,528,911, the patent discloses two embodiments, a first embodiment in Figures 3a-3d and a second embodiment in Figures 4a-4c, in which reference numerals for like structures are used in the description of both embodiments.

Given the all the different claims of the present application and different rejections of the claims and different embodiments in De Petris, each of the following discrepancies cited below when considered alone, or in combination, render the Office Action improper under MPEP 706:

1. The explanation of the anticipation rejection does not match with the terms or features of Claims 1-12 and 20-22. Rather the para. 2 explanation matches terms and features found in Claims 13-19 with reference numerals from De Petris. Applicant believes that the explanation of the anticipation rejection appears as though it was actually written to appear in para. 4 under the explanation of the obviousness rejection.
2. In addition to using language from claims rejected in para. 4 not para. 2, the explanation in para. 2 further relies upon other prior art embodiments found in the background of De Petris to introduce epoxy, such a maneuver is appropriate for an obviousness rejection as under para. 4, but not an anticipation rejection under para. 2.
3. Para. 2 of the Office Action fails to indicate whether the claims are anticipated by the De Petris embodiment of Figures 3a-3d or the De Petris embodiment of Figures 4a-4c.
4. The obviousness rejection recited in para. 4 does not state whether the claims are rendered obvious in view of Keider et al. by the first embodiment of Figures 3a-3d or the second embodiment of Figures 4a-4c.

The Office Action is improper under MPEP 706 as the remarks fail to provide any explanation as to why the inventive features found in Claims 1-12 and 20-22 are unpatentable by De Petris. The explanation for the rejection of Claims 1-12 and 20-22 compares De Petris to inventive features found in non-rejected Claims 13-19. Applicant has no idea what this explanation means in terms of claims 1-12 and 20-22.

Applicant therefore requests that the Office Action be resubmitted with a proper written explanation for the grounds for rejection of Claims 1-12 and 20-22 in accordance with MPEP 706 or the rejection be withdrawn.

V. Rejection of Claims 1-12 and 20-22 under 35 USC 102:

Claims 1-12 and 20-22 stand rejected under 35 USC 102 as being anticipated by De Petris.

MPEP 2131 requires:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

For the reasons given above as to an improper Office Action under MPEP 706, applicant points out that no explanation has been given to support this rejection. Given that there are two embodiments in De Petris and 15 claims, applicant cannot determine the basis or reasoning used by which De Petris anticipates Claims 1-12 and 20-22. As explained above, Applicant does not understand the basis of Examiner's rejection. For example, all of Claims 1-12 and 20-22 feature a diode compartment. However, no diode compartments appear to be found in De Petris. Additionally, many of the claims feature heat conductive epoxy, yet neither the embodiment found in De Petris uses epoxy.

Applicant therefore requests that the Office Action be resubmitted with a proper written explanation establishing that De Petris teaches every claim element of Claims 1-12 and 20-22 in accordance with MPEP 2131 or the rejection be withdrawn.

VI. Rejection of Claims 13-19 under 35 USC 103:

By the Office Action claims 13-19 have been rejected under 35 U.S.C. § 103 as being unpatentable over De Petris in view of Keidar et al. (US Patent No. 6,731,030) and in view of prior art discussed in col. 2, lines 14-17 of De Petris. Applicant traverses the rejection given that the references when combined fail to establish the basic requirements of *prima facie* obviousness.

As a preliminary matter Applicant assumes that the explanation provided in paragraph 2 of the Office Action actually relates to the present rejection presented under paragraph 4 of the Office Action. Further for purposes of this rejection, it is assumed that the examiner was referring to the De Petris embodiment of Figures 3a-3d. The remainder of this response will be upon these assumptions.

MPEP 2143 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In relation to all of claims 13-19 the rejection is improper as there is no teaching or suggestion to modify the De Petris embodiment found in Figures 3a-3d to include epoxy found in a quotation of prior art in col. 2, lines 14-17 of De Petris. MPEP 2143.01 states “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” De Petris actually teaches eliminating the epoxy. See col. 3, lines 7-10, “It also instantly dissipates their heat out directly into the outside cooling air, being affixed directly onto copper assemblies

and stator terminals, which are in direct contact with the cooling air flow.” Furthermore, De Petris uses springs 138 to hold the diode in place. If De Petris were modified to include epoxy, the springs 138 would not function, as they would be encased in the epoxy. For each of these reasons the rejection of claims 13-19 is improper as there is no suggestion or motivation for the modification, given that the modification of De Petris to include epoxy would render it unsuitable for its intended purpose. For this reason alone the rejection of claims 13-19 is improper and should be withdrawn.

With regard to Claim 13, the rejection is improper given reasons asserted above and that the references fail to teach or suggest all of the claim features. For example, De Petris fails to teach “a plurality of wells formed into said positive lead in which a first portion of said wells have a bottom formed in said positive lead and a second portion of said wells have a bottom formed in said negative lead.” (Emphasis Added). For this reason alone, the rejection of Claim 13 is improper and should be withdrawn. In addition, the prior art quotation in De Petris at col. 2, lines 14-17 fails to disclose epoxy as featured in claim 13 that includes “thermally conductive and electrically non-conductive epoxy”. For this reason alone, the rejection of Claim 13 is improper and should be withdrawn.

With regard to Claims 14 and 15, these claims depend from claim 13 and for the reasons given above, the rejection of these claims is improper and should be withdrawn.

With regard to claim 16, the rejection is improper given reasons asserted above and that the references fail to teach or suggest all of the claim features. For example, De Petris fails to teach “a second finned base plate mounted to the alternator in spaced apart relation to said first base plate and providing a positive lead.” (Emphasis Added) An illustration of an example of this configuration is shown in Figure 14 of the present application. For this reason alone the rejection of Claim 16 is improper and should be withdrawn.

In addition, De Petris fails to disclose "a plurality of wells formed into said first and second base plates." The Examiner improperly refers to cavity nests 179 as wells. However, the upper portion of the diodes 183 completely overlies the cavity nest 179 and clear that could not be used to fill the cavity nests. For this reason alone the rejection of Claim 16 is improper and should be withdrawn.

Finally, the prior art quotation in De Petris at col. 2, lines 14-17 fails to disclose epoxy as featured in claim 13 that includes "thermally conductive and electrically non-conductive epoxy". For this reason alone, the rejection of Claim 16 is improper and should be withdrawn.

With regard to Claims 17, 18 and 19, these claims depend from claim 16 and for the reasons given above, the rejection of these claims is improper and should be withdrawn.

VII. Petition for a One Month Extension of Time:

Applicant hereby petitions for a one-month extension of time to extend the period for a response from December 2, 2004 to January 2, 2005. A one-month extension fee in the amount of \$60.00 is enclosed.

Note: Given that January 2, 2005 is a Sunday, this Response is being filed on January 3, 2005.

VIII. Summary:

Applicant believes that all the Examiner's rejections have been addressed and overcome.

None of the references, either alone, or in combination, anticipate or render obvious the invention claimed in Claims 1-22. Accordingly, allowance of the presently pending claims is respectfully requested.

Respectfully submitted,

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Amendments to the Drawings

The attached sheet of drawings includes changes to Fig. 10. This sheet, which includes Figs. 8-10, replaces the original sheet including Figs. 8-10. In Figure 10, previously omitted element 120 has been added.

Attachment:

Replacement Sheet

Annotated Sheet Showing Changes

